

REMARKS

Claims 1-10, 12, and 13 are pending in the present application.

The rejections of: (a) Claims 1-6, 12, and 13 under 35 U.S.C. §103(a) over Barsa (US 4,540,781) in view of Bechara et al (US 4,404,992), and (b) Claims 7-10 and 13 under 35 U.S.C. §103(a) over Barsa (US 4,540,781) in view of Bechara et al (US 4,404,992) and further in view of Brandt et al (US 5,489,663) is respectfully traversed.

In the outstanding Office Action the Examiner restates the previous rejections with a more specific explanation as to why it is believed that the claimed invention would be allegedly obvious. Specifically, the Examiner recognizes that Barsa fails to disclose or suggest an  $\alpha$ -hydroxy carboxylates ion.

The Examiner cites Bechara et al as allegedly compensating for this deficiency. In making this allegation, the Examiner points to column 4, lines 17-30 of Bechara et al, which discloses that a large variety of carboxylic acids may be employed to furnish the anion of the desired quaternary ammonium salt. The Examiner further cites Example 10 of Bechara et al, which illustrates an  $\alpha$ -hydroxy carboxylate (i.e., glycolic acid). In addition, the Examiner cites Example 7 of Bechara et al, which allegedly shows that a functional equivalence exists between alpha and non-alpha-hydroxy carboxylate ions.

The Examiner then alleges that “it would have been obvious to use the  $\alpha$ -hydroxy-carboxylates ion of Bechara because the catalysts would be more compatible with the components employed in premixes and for formulations for polyisocyanurate and polyurethane resins and because of the surface active properties of these catalysts and the lowered viscosity (Bechara, Column 17, lines 36-42)”. Applicants submit that this is a misquote of Bechara et al, which does not provide any such statement of being “more

compatible” than anything else. Indeed, the Examiner makes no attempt to answer the question: more compatible than what?

Further, Example 10 relied upon by the Examiner is not even an  $\alpha$ -hydroxy carboxylate within the scope of Claim 2 of the present invention. Thus, Bechara et al does not disclose or suggest how an  $\alpha$ -hydroxy carboxylate within the scope defined in Claim 2 would actually behave in system such as that claimed or even as disclosed in Barsa or Bechara et al.

Moreover, Applicants submit that it is an object of the present invention to provide a catalyst for preparing substantially colorless isocyanurate-containing polyisocyanates (see page 2, lines 40-41). As stated on page 13, lines 16-20, polyisocyanates having isocyanurate groups and prepared by these process variants of the present invention are suitable preferentially for producing polyurethane coatings, for example textile and leather coatings, for polyurethane dispersions and adhesives, and find use in particular as a polyisocyanate component in one- and two-component polyurethane systems for high-grade, weather-resistant polyurethane coatings and high-solids coatings. Quite plainly stated, none of Barsa, Bechara et al, or Brandt et al disclose or suggest the claimed invention and/or the beneficial effects flowing therefrom, especially with respect to the fact that the use of  $\alpha$ -hydroxy-carboxylic acids as in the presently claimed invention result in polyisocyanates with lower color numbers.

“Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. “Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.” No set number of examples of superiority is required. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987)” Thus, the data in the specification clearly illustrates that inclusion of an  $\alpha$ -hydroxy carboxylate provides for significant differences in the color number of the product

obtained, which are enough to rebut a *prima facie* case of obviousness.

Specifically, Applicants direct the Examiner's attention to the Examples of the present application, which clearly demonstrate that the  $\alpha$ -hydroxyl carboxylic acids give rise to polyisocyanates with a lower color number. Specific reference is made to the following comparisons:

Example 1 (color number of 30 Hz) vs. Comparative Example 1 (color number of 53 Hz)

Example 4 (color number of 17 Hz) vs. Comparative Example 2 (color number of 61 Hz)

Example 5 (color number of 180 Hz) vs. Comparative Example 3 (color number of 800 Hz)

Applicants submit that the results demonstrated in these comparisons clearly illustrate that, even if a *prima facie* case of obviousness can be established, Applicants demonstration is sufficient to rebut the same.

In view of the foregoing, withdrawal of these grounds of rejection is requested.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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